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FULBRIGHT AND JAWORSKI
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EXAMINER

PELLEGRINO, BRIAN E

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHANNES REINMULLER

Appeal 2009-007172
Application 08/732,408
Technology Center 3700

Decided: April 26, 2010

Before JENNIFER D. BAHR, STEFAN STAICOVICI, and
FRED A. SILVERBERG, *Administrative Patent Judges*.

STAICOVICI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Johannes Reinmuller (Appellant) appeals under 35 U.S.C. § 134 (2006) from the Examiner's decision rejecting claims 129-170 and 175-181. Claims 1-128 and 171-174 have been canceled. We have jurisdiction over this appeal under 35 U.S.C. § 6 (2006).

THE INVENTION

Appellant's invention relates to plastic implants for medical purposes.
Spec. 1.

Claim 129 is representative of the claimed invention and reads as follows:

129. A medical implant comprising at least one continuous, solid spaghetti-like strand comprising a physiologically compatible material surrounded by an outer covering.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Chapman	US 4,348,329	Sep. 7, 1982
Taylor	US 4,657,553	Apr. 14, 1987
Perry	US 5,282,857	Feb. 1, 1994
Fisher	US 5,496,367	Mar. 5, 1996
Henley	US 5,534,023	Jul. 9, 1996
Shimizu	US 5,607,590	Mar. 4, 1997
Ledergerber	EP 0 322 194 A1	Jun. 28, 1989

The following rejections are before us for review:

The Examiner rejected claims 129-132, 135-141, 147, 149, 152-155, 160, and 167-170, and 175-181 under 35 U.S.C. § 102(e) as anticipated by Henley.

The Examiner rejected claims 133, 134, and 158 under 35 U.S.C. § 103(a) as unpatentable over Henley and Fisher.

The Examiner rejected claims 142, 144-146, 148, and 150 under 35 U.S.C. § 103(a) as unpatentable over Henley and Shimizu.

The Examiner rejected claims 156 and 157 under 35 U.S.C. § 103(a) as unpatentable over Henley and Perry.

The Examiner rejected claims 143, 161, and 162 under 35 U.S.C. § 103(a) as unpatentable over Henley and Taylor.

The Examiner rejected claim 159 under 35 U.S.C. § 103(a) as unpatentable over Henley, Shimizu, and Fisher.

The Examiner rejected claim 163 under 35 U.S.C. § 103(a) as unpatentable over Henley, Fisher, and Chapman.

The Examiner rejected claims 164-166 under 35 U.S.C. § 103(a) as unpatentable over Henley and Ledergerber.

OPINION

We shall not sustain the Examiner's rejection of claims 129-170 and 175-181 under 35 U.S.C. §§ 102(e) and 103(a). For the reasons expressed below, independent claims 129, 147, and 175, and dependent claims 130-146, 148-170, and 176-181, are indefinite. Therefore, the prior art rejections must fall because they necessarily are based on speculative assumptions as to the meaning of the claims. *See In re Steele*, 305 F.2d 859, 862-63 (CCPA

1962). It should be understood, however, that our decision in this regard is based solely on the indefiniteness of the claimed subject matter, and does not reflect on the adequacy of the prior art evidence applied in support of the rejections.

NEW GROUND OF REJECTION

We make the following new ground of rejection pursuant to 37 C.F.R. § 41.50(b)(2007).

Claims 129-170 and 175-181 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention which applicant regards as the invention.

The essence of the requirement under 35 U.S.C. § 112, second paragraph, that the claims must be definite, is that the language of the claims must make it clear what subject matter the claims encompass. *In re Hammack*, 427 F.2d 1378 (CCPA 1970). The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) (citations omitted).

Each of independent claims 129, 147, and 175 requires a "spaghetti-like strand." At the outset, we note that "strand" is modified by "spaghetti-like" in the phrase "spaghetti-like strand." The disclosure in the instant application does not include a definition of the terms "spaghetti-like" and "strand." Appellant's Specification refers to "silicone spaghetti" as having a "strand form" (Spec. 5) or as "strand-like silicone rubber" (Spec. 10). Although Appellant's disclosure characterizes "spaghetti" as both a "strand" and "strand-like," Appellant's disclosure does not provide any indication as

to what constitutes “spaghetti-like.” In other words, Appellant’s disclosure does not provide any indication as to what is the difference between a “spaghetti” strand and a “spaghetti-like” strand.

Hence, the limitation “spaghetti-like” is indefinite because it is unclear which features the claimed “strand” must possess in order to constitute a “spaghetti-like” strand. Moreover, we note that an ordinary and customary meaning of the term “strand” is “fibers or filaments twisted, plaited, or laid parallel for further twisting or plaiting into yarn, thread, rope, or cordage.”¹ Yet, Appellant’s disclosure does not describe or show “the strands” as being twisted or plaited. See Figures 2 and 3 of Appellant’s Drawings.

In other words, we conclude that the term “spaghetti-like” and “spaghetti-like strand” as used in the claims, when construed in view of Appellant’s disclosure, lacks sufficient precision to permit one endeavoring to practice the invention to determine the metes and bounds thereof.

In light of the above, we conclude that independent claims 129, 147, and 175, and dependent claims 130-146, 148-170, and 176-181 are indefinite under 35 U.S.C. § 112, second paragraph, for failing to particularly point and distinctly claim the subject matter which Appellant regards as the invention.

SUMMARY

The decision of the Examiner to reject claims 129-170 and 175-181 is reversed.

¹ MERRIAM-WEBSTER’S COLLEGIATE DICTIONARY (10th ed. 1996).

We enter a new ground of rejection of claims 129-170 and 175-181 under 35 U.S.C. § 112, second paragraph.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b)(2007). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

REVERSED; 37 C.F.R. § 41.50(b)

Appeal 2009-007172
Application 08/732,408

mls

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